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10/593,727	09/21/2006	Jun Takahashi	2006_1310A	2849

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EXAMINER	
HARVEY, DAVID E	

ART UNIT	PAPER NUMBER
2621	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/593,727	TAKAHASHI ET AL.	
	Examiner	Art Unit	
	DAVID E. HARVEY	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/7/2009 and 9/21/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. **The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.**

2. **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter**.

The preamble of claim 23 indicates that claim 23 is directed to a computer "program" per se. Computer programs constitute non-functional descriptive material and, as such, do not fall within the scope of Section 101. That is, a computer program is not a process, a machine, a manufacture, or a composition of matter as is required under Section 101; i.e., such "programs" constitute non-statutory subject matter.

4. **Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter**. **The following is noted**:

A) A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

B) The instant specification clearly indicates that the instant invention is inclusive of a "general purpose computer" running an appropriate computer program **[i.e., See paragraph 0014].** As such, it is the examiner's position that the "unit operable to" terminology recited in lines 2 and 11 of claim 1 encompass units of computer programming/"software" when such recitations are fairly construed in light of the instant specification (i.e., given the broadest reasonable interpretation). As noted above with respect to claim 23, computer programs constitute non-functional descriptive material and, as such, do not fall within the scope of Section 101. That is, a computer program is not a process, a machine, a manufacture, or a composition of matter as is required under Section 101; i.e., such "programs" constitute non-statutory subject matter.

5. **Claims 2-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the same reasons that were set forth above with respect to claim 1**.

6. **Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the same reasons that were set forth above with respect to claim 1**.

> Again, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

7. **The following "prior art" it noted:**

I. US Patent #7,249,105 to Peinado et al:

As is shown in Figure 3, Peinado et al describes a system (@ 200) for receiving distributing digital content (@ "P") representing a digital "good" such as music, video, book, etc,… The system comprises:

1) A source (@ 202) of the digital content (@ "P"), wherein said source is located within the content providing computer/terminal (@ 26);

2) A digital content splitter (@ 204), located in the content providing computer/terminal (@ 26), for splitting the digital content into:

a) A first digital content portion (@ "P1"); and

b) A second digital content portions (@ "P2");

3) A first digital content delivery medium (@ 202) for delivering the first digital content portion (@ "P1") to the consuming computer/terminal (@ 22);

4) A first individualizing unit (@ 214), located in the content providing computer/terminal (@ 26), for modifying the second digital content portion (@ "P2") for producing a modified second digital content portion (@ "Q2");

5) A second digital content delivery medium for delivering the modified second digital content portions (@ "Q2") to the consuming computer/terminal (@ 22);

6) A second individualizing unit (@ 208), located in the content consuming computer/terminal (@ 22), for modifying the first digital content portion (@ "P1") provided from the first delivery medium;

and

7) A combiner (@ 216), located in the content consuming computer/terminal (@ 22), combining the modified first and second digital content portions to generate a combined content ("Q" @ 218) which is functionally equivalent to the original digital content ("P").

[Note lines 4-43 of column 6]

II. PCT Patent Document #WO 2004/032510 to LeComte et al.:

A) "Prior art" PCT document #WO 2004/032510 is not written in the English language. As such, the examiner relies on US Patent Document #2005/0185821 as comprising an English translation thereof;

B) This "prior art" is cited for the following teachings:

1) That it was recognized by those of ordinary skill in the art that conventional video scrambling systems were known to have been disadvantageous in that despite the scrambling, all of the information content of the original video signal content was contained in the scrambled signal. Thus, if the scrambling process can be broken by a "pirate", all of the original video information content can be obtained/stolen by said pirate **[e.g., Note paragraph 0003 of US Patent Document #2005/0185821 and, more particularly, the last three lines thereof]**;

2) That the system described above in section "I." of this paragraph was recognized by those of ordinary skill in the art as being an improvement over such conventional scrambling systems because it divided the content into separate portions and, as such, only a portions of the content can be obtained/stolen even if/when the scrambling process is broken **[e.g., See paragraph 0010 of US Patent Document #2005/0185821].**

C) The invention that is actually described in PCT document #WO 2004/032510 is an improvement over the existing prior art in that it divides the original video signal content into a main video signal portions and a complementary video signal portion, wherein the main video signal portion keeps its nominal video signal format and, as such, produces a highly degraded version of the content when displayed alone. However, when properly combined with the complementary portion of the video signal content, said original video signal content is fully restored/recovered **[e.g., Note paragraphs 0012, and 0017-0020 of US Patent Document #2005/0185821]**;

III. PCT Patent Document #WO 2004/032418 to LeComte et al.:

A) "Prior art" PCT document #WO 2004/032418 is not written in the English language. As such, the examiner relies on US Patent Document #2005/0185793 as comprising an English translation thereof;

B) This "prior art" is cited because it describes a system/process in which an original audio content is transmitted through the system by dividing it into a nominal main audio content portion and a complementary audio content portion, wherein:

1) The complementary audio content portion comprise "valid" data extracted from the original audio content; and

2) The nominal main audio content portion main contains "invalid" data that has been used to replace/substitute the extracted "valid" content,

whereby the nominal main audio content produces a highly degraded audio presentation when displayed alone, and produces the original audio content when the invalid data is replaced by the valid data of the complementary audio content.

[e.g., Note paragraphs 0024, and 0046-0053 of US Patent Document #2005/0185793].

IV. PCT Patent Document #WO 2004/032478 to LeComte et al.:

A) "Prior art" PCT document #WO 2004/032478 is not written in the English language. As such, the examiner relies on US Patent Document #2005/0193409 as comprising an English translation thereof;

B) The examiner notes that this "prior art" is similar, if not analogous to, the prior art cited above in part III of this paragraphs; i.e., the most significant difference being that the instant prior art is directed to video content wherein that of part III was directed to audio content.

C) This "prior art" is cited because it describes a system/process in which an original video content is transmitted through the system by dividing it into a nominal main video content portion and a complementary video content portion, wherein:

1) The complementary video content portion comprise "valid" data extracted from the original video content; and

2) The nominal main video content portion main contains "invalid" data that has been used to replace/substitute the extracted "valid" content,

whereby the nominal main video content produces a highly degraded video presentation when displayed alone, and produces

the original video content when the invalid data is replaced by the valid data of the complementary video content.

[e.g., Note paragraphs 0004, 0011-0014, 0020-0022, and 0044-0046 (particularly the last 4 lines of 0045) of US Document #2005/0193409].

V. PCT Patent Document #WO 2004/015996 to LeComte et al.:

"Prior art" PCT document #WO 2004/015996 is being directed to a further configuration of a scrambling system in which data content is separated into respective components.

8. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Patent Document #WO 2004/032478 to LeComte et al [The examiner hereby relies on US Patent Document #2005/0193409 as comprising an English translation thereof] in view of PCT Patent Document #WO 2004/032418 to LeComte et al [The examiner hereby relies on US Patent Document #2005/0185793 as comprising an English translation thereof].**

> **A)** As was set forth above in part "IV." of paragraph 7 of this Office action, Lecomte et al '478 describes a system/method ***of moving original video signal content***. As discussed with respect to the Figure, the system/method includes:
>
> 1) A source (@ 101) of first video data content data (@ 111);
>
> 2) A scrambling system (@ 121) ***for writing*** second content data into a second memory medium (@ 122 and/or 85) wherein the second content is different from the first content data in that it has been "re-coded" by:
>
> a) Extracting valid partial content data from the first video content data; and
>
> b) Inserting invalid partial information content data in place of the extracted valid partial content data;

thereby ***making*** the re-coded second content data "irreproducible" without severe visual degradation relative to the first video content data (i.e., if at all);

3) Said scrambling system (@ 121) ***for writing*** the extracted valid partial video content data into a third memory medium (@ 123 and/or 86); and

4) A viewer terminal (@ 8) for:

a) Receiving the second content data (@ 85) and the valid partial content data (@86); and

b) Synthesizing/combining the received second content data and valid partial content data, e.g., by replacing the invalid data of the second content data with the valid data of the valid partial content data, to ***restore/recover*** the original first video content data.

B) Claim 22 differs from the showing of Lecomte et al '478 only in that the two contents (i.e., main and complementary) are described as being conveyed and stored by separate mediums.

C) As was set forth above in part "III." of paragraph 7 of this Office action, Lecomte et al '418 describes a system/method that is similar, if not analogous, to that described in Lecomte et al '478. Lecomte et al '418, however, explicitly recognized the obviousness of having provided the two contents (i.e., main and complementary) together via the same medium [Note: the last 3 lines of paragraph 0040; and claim 3 of US Patent Document #2005/0185793].

D) It would have been obvious to one of ordinary skill in the art to have modified the system disclosed by Lecomte et al '478, in accordance with the teaching of Lecomte et al '418, whereby the two contents (i.e., main and complementary) are provided and stored via the same/common media; i.e., such modification representing the substitution of known alternatives.

10. **Claims 1, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Patent Document #WO 2004/032478 to LeComte et al [The examiner hereby relies on US Patent Document #2005/0193409 as comprising an English translation thereof] in view of PCT Patent Document #WO 2004/032418 to LeComte et al [The examiner hereby relies on US Patent Document #2005/0185793 as comprising an English translation thereof] for the same reasons that were set forth above for claim 22. Additionally:**

The examiner maintains that it would have been obvious to one of ordinary skill in the art to have implemented the terminals 12 and 8 in the modified system of Lecomte '478 using software driven general purpose computer/processing terminals given the known advantages associated with such a configuration (i.e., reduced cost, ease of updating, etc,…). As addressed in paragraphs 2-6 of this Office action, each of claims 1, 23, and 24 appears to read on such a software configuration/implementation.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY
Primary Examiner
Art Unit 2621